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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, [redacted] 1918

No. [redacted] 278

DAVID F. MOORE, APPELLANT,

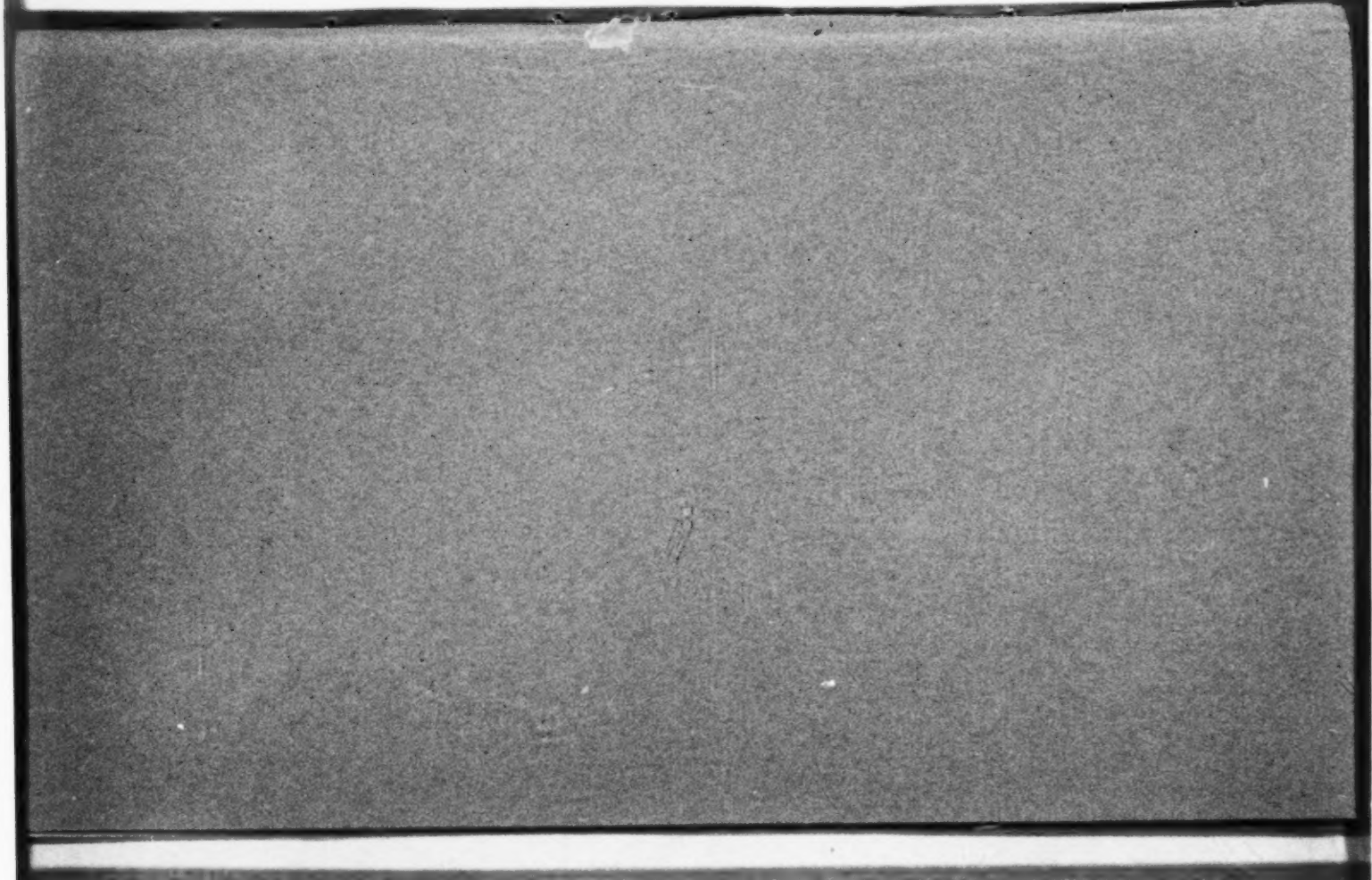
vs.

THE UNITED STATES.

APPEAL FROM THE COURT OF CLAIMS.

FILED SEPTEMBER 21, 1917.

(26,163)



(26,163)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1917.

No. 696.

DAVID F. MOORE, APPELLANT,

vs.

THE UNITED STATES.

APPEAL FROM THE COURT OF CLAIMS.

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., SEPTEMBER 24, 1917.

1 Court of Claims.

No. 33694.

DAVID F. MOORE

vs.

THE UNITED STATES.

I. *Petition and History of Proceedings.*

The original petition in this case was filed December 29, 1916.

On February 9, 1917 the defendants filed a motion to dismiss claimant's petition.

Subsequently, to wit, on March 14, 1917, by leave of Court, the claimant filed an amended petition, which is as follows:

2 II. *Amended Petition. Filed March* 14, 1917.

To the Honorable the Judges of the Court of Claims of the United States:

The petition of David F. Moore respectfully represents:

1. That he is a citizen of the United States, residing at Seattle, in the County of King, State of Washington, and that he files this petition under the provisions of the act of June 25, 1910, (36 Stat., 851) to recover reasonable compensation for the use by the United States of the inventions described in and covered by Letters Patent
3 No. 1,114,903, granted to him by the United States on the 27th day of October, 1914; and thereupon your petitioner complains and says:

2. That during the years 1903 to 1914, inclusive, he invented a tool to be used as reefing iron on the decks, sides, and bottoms of vessels where wood-caulking is done;

That on the 29th day of July, 1914, he presented his petition to the Commissioner of Patents for a patent upon his inventions, and upon due and full compliance with the statutes made and provided, as aforesaid, a patent numbered 1,114,903 was granted to him on the 27th day of October, 1914;

That his invention which the United States Government has adopted, used, and is using, in the caulking of vessels, and especially war vessels, is specifically set forth in claims 1, 2, and 3, to-wit, as follows:

1. "A reefing tool comprising a handle with an integral head laterally extended and bifurcated at the extremity, and with a vertical blade adapted to enter and to be guided by a seam substantially as and for the purpose set forth.

2. "In a reefing tool such as described, comprising a handle; a

head with lateral projections and bifurcated at the forward extremity; a throat in the upper surface of the bifurcated portions to receive and guide away the material removed from the seam, substantially as shown and described.

3. "In a reefing tool such as described comprising a handle a head with lateral projections bifurcated at the forward end, and a
4 vertically projected blade adapted to enter a seam an independent blade located within the bifurcation of the lateral projections and removably secured within a longitudinal recess in the head, substantially as and for the purpose set forth.

That the manner of practicing his invention is more fully set forth and explained in the specification of his patent, numbered 1,114,903 granted October 27, 1914, aforesaid;

3. That he has been at all times during the life of said patent the sole and exclusive owner of said inventions, and of said Letters Patent No. 1,114,903, therefor; that he is the sole and exclusive owner of the claim herein stated, and that no action on said claim has been had in Congress, or by any of the departments of the Government; that your petitioner has, at all times, borne true allegiance to the Government of the United States, and has not in any way aided, abetted, or given encouragement to rebellion against the Government;

4. That your petitioner is advised and believes, and therefore avers, that the said Letters Patent No. 1,114,903 is avail and effectual in law to secure to your petitioner the exclusive rights and privileges thereby granted, and that by the infringement herein complained of your petitioner has, during the entire term of said letters patent, been wholly deprived, by the United States, of the possession, use and enjoyment of the said invention, of the exclusive rights and privileges secured under the patent, and of the profits arising from the unauthorized use thereof;

5. That on or about March 26, 1913, the petitioner com-
5 menced working at the United States Navy Yard at Bremerton, Washington, as a first-class wood-caulker, and that after so working for about a month he was placed in charge of the wood-*ch*aulking crew in said navy yard, which position he held until July 16, 1914; that during the month of May, 1914, your petitioner, after expending a great deal of time, labor, and study, completed his invention of the tool above mention-, and thereupon applied for patent upon it, as above stated; that prior to the issuance of patent this tool has been constantly used with great success on United States war vessels in said yard, but that on or about July 16, 1914, your petitioner left the employ of the Government, and then and there forbid the use of the said tool; but that regardless of his instructions the officials and employees of the Government continued using the tool in said yard, and are still using it, and are recommending it very highly; and that during the hours of his said employment petitioner did no work upon his invention, but that such work as was performed upon it subsequent to March 26, 1913, was performed at petitioner's home during his absence from duty at the said Bremerton Navy Yard.

6. Therefore, your petitioner avers that the United States, through its officers and agents, well knowing the exclusive rights granted as aforesaid, and especially through the officers and employees of the said Navy Yard at Bremerton, Washington, and before the filing of this petition, without license of your petitioner, or without lawful right, made, constructed, and used the tool embodying in use the invention covered and claimed in said Letters Patent No. 1,114,903

6 in violation and infringement of said Letters Patent, and of the rights of your petitioner thereunder; that such unlawful and unauthorized use of your petitioner's said patented invention has resulted in great injury, damage, and loss to your petitioner, to-wit, as your petitioner is informed and believes and avers to the aggregate sum of $30,000 profits, and which sum, or such other reasonable compensation, for the use by the United States of your petitioner's said patented inventions, as this honorable court may find to be due your petitioner, your petitioner avers that he is justly entitled to recover, after allowing all just credits and off-sets;

7. Therefore, your petitioner prays judgment in his favor against the United States for the sum of $30,000 and for such other and further relief as the court may deem just.

SAMUEL HERRICK,
Attorney of Record.

P. M. LIDDY,
Of Counsel.

7 CITY OF WASHINGTON,
District of Columbia, ss:

Samuel Herrick, being duly sworn deposes and states that he is the attorney for the petitioner in above entitled cause, and that the allegations in the foregoing petition are true, to the best of his knowledge, information and belief.

(Signed) SAMUEL HERRICK.

Sworn and subscribed to before me this 21st day of March, 1917.

S. A. TERRY,
Notary Public.

8 III. *Defendant's Renewed Motion to Dismiss.*

Filed March 27, 1917.

Comes now the Defendant, by its Attorney General, and moves the Court to dismiss the amended petition herein on the ground that the same does not set forth a cause of action of which this Court has any jurisdiction.

The grounds for the renewed motion are in brief as follows:

Motion was made to dismiss the original petition for want of jurisdiction and plaintiff then amended his petition with a view to removing the objections against which the original motion was directed.

If the jurisdictional act (Act of June 25, 1910) be construed in accordance with its language, it is submitted that the amendment to the original petition does not remove the bar to jurisdiction specified in said Act and in the last proviso thereof.

The Act has never been judicially interpreted, particularly as to this last proviso that defendants submits bars the jurisdiction of the court in the circumstances as alleged in the original and amended petitions.

A full brief will be filed prior to the time of hearing the motion.

HUSTON THOMPSON,
Assistant Attorney General.

H. C. WORKMAN,
Attorney.

9 IV. *Argument and Submission of Motion.*

On April 23, 1917 the defendant's motion to dismiss the claimant's amended petition was argued by Mr. H. C. Workman, for the motion, and by Mr. Samuel Herrick, in opposition thereto, and the motion was thereupon submitted.

10 V. *Order of Court on Defendant's Motion to Dismiss Amended Petition.*

Filed May 21, 1917.

It is Ordered by the Court that the defendants' motion to dismiss be and the same is hereby allowed, and the petition is dismissed.

The court is of opinion that the proviso in the act of June 25, 1910, 36 Stats., 851, excludes the plaintiff's claim in that said proviso provides that the act shall not apply to any device discovered or invented by an employee of the United States during the time of his employment or service. The claim being for an infringement of a patent the court is therefore without jurisdiction.

BY THE COURT.

11 VI. *Claimant's Application for, and Allowance of, Appeal.*

From a judgment rendered in this case on the 21st day of May, 1917, the claimant, David F. Moore, by his attorney, hereby makes application for and gives notice of an appeal to the Supreme Court of the United States.

SAMUEL HERRICK,
Attorney for Claimant.

Filed August 9, 1917.

Ordered: That the above appeal be allowed as prayed for.

EDWARD K. CAMPBELL,
Chief Justice.

September 19, 1917.

12 Court of Claims.

No. 33694.

DAVID F. MOORE

vs.

THE UNITED STATES.

I, Sam'l A. Putman, Chief Clerk Court of Claims, certify that the foregoing are true transcripts of the pleadings in the above-entitled cause; of the order of the Court allowing the defendant's motion to dismiss the claimant's petition and dismissing the petition; of the claimant's application for, and allowance of, an appeal to the Supreme Court of the United States.

In Testimony Whereof I have hereunto set my hand and affixed the seal of said Court of Claims this 20th day of September, A. D., 1917.

[Seal Court of Claims.]

SAMUEL A. PUTMAN,
Chief Clerk Court of Claims.

Endorsed on cover: File No. 26,163. Court of Claims. Term No. 696. David F. Moore, appellant, vs. The United States. Filed September 21st, 1917. File No. 26,163.

Office Supreme Court, U. S.
FILED
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JAMES D. MAHER,
CLERK.

IN THE

Supreme Court of the United States

October Term, 1918.

No. 278.

DAVID F. MOORE, *Appellant*,
v.
THE UNITED STATES, *Appellee*.

ON APPEAL FROM THE COURT OF CLAIMS.

BRIEF ON BEHALF OF APPELLANT.

SAMUEL HERRICK,
Attorney for Appellant.

P. M. LIDDY,
Of Counsel.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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IN THE

Supreme Court of the United States

October Term, 1918.

No. 278.

DAVID F. MOORE, *Appellant*,

v.

THE UNITED STATES, *Appellee*.

ON APPEAL FROM THE COURT OF CLAIMS.

BRIEF ON BEHALF OF APPELLANT.

I.

STATEMENT OF FACTS.

This case arose in the United States Court of Claims. The petition, after amendment duly allowed by the court, set up that the appellant had during the years 1903 to 1914, inclusive, invented a tool to be used as a reefing iron on the decks, sides, and bottoms of vessels where wood-caulking is done; that between March 26, 1913, and July 16,

1914 the appellant was working at the United States Navy Yard at Bremerton, Washington, as a wood-caulker, and that during such time the tool aforesaid was used with great sucess on the war vessels in said yard, and that upon his leaving the employ of the Government he forbid the use of said tool; that notwithstanding this, the officials and the employees of the Government continued to use the tool in that yard, and were still using it at the time of the filing of the petition; that during the hours of his employment he did no work upon his invention, but performed such work subsequent to March 26, 1913, at appellant's home during his absence from duty at the said navy yard; that on July 29, 1914, appellant filed his application with the Commissioner of Patents for a patent upon his invention, and that patent No. 1,114,903 was granted to him on October 27, 1914. For such unauthorized use of his invention in violation and infringement of his said letters patent, appellant claimed damages in the amount of $30,000, or such other reasonable compensation as the court might find to be due him under the act of June 25, 1910 (36 Stat., 851).

This amended petition the defendant moved to dismiss under authority of the last proviso to the said act of June 25, 1910, to-wit, "nor shall this act apply to any device discovered or invented by such employee (of the Government of the United States), during the time of his employment or service."

After argument, this motion was sustained by the Court of Claims and the petition dismissed without the rendition of any opinion (52 Ct. Cls., 532).

Appeal from that judgment brings the case before this Honorable Court for adjudication.

II.

ARGUMENT.

Appellant's Device Was "Discovered or Invented" Prior to the Time of His Employment or Service with the Government.

While the petition stated that the invention was "completed during the month of May, 1914," it also alleged the invention was made "during the years 1903 to 1914, inclusive," and we therefore urge that the device was not discovered or invented during the period between March 26, 1913, and July 16, 1914, when alone the appellant was in the service of the United States.

Defendant, by his motion, invoked and the court below made, a very narrow construction of the said Act of 1910, notwithstanding that said Act was in the language of Mr. Chief Justice White (Crozier v. Fried. Krupp Aktiengessell, 224 U. S., 290, 305, 307), one with "plain and beneficent purpose" "to add additional protection and sanction to private rights," and one "implying the pledge of the good faith of the Government"; in fact, a remedial statute and hence to be liberally construed. It well nigh overlooked or ignored the appellant's allegation that he was engaged upon his invention during a period of twelve years, namely, "during the years 1903 to 1914, inclusive." It therefore appears that when appellant entered the Government service in March, 1913, he had invented the tool in question, or at least had conceived the idea and had substantially reduced the same to practice, although he may not have entirely completed and been in a position to file a patent application until the month of May, 1914.

The words "discovered or invented" are used in apposition in the said statute, and should be construed in much the

same sense. A new process, invention or principle might be "discovered" when the specific idea first enters the inventor's mind, and such delivery does not have to wait upon the time when the inventor has finally reduced his idea to practice or even when he first made a workable model or drawings. And by a parity of reasoning the new idea or process or machine might be "invented" when the inventor first conceives the plan and before he has converted it into such a form that he might file a patent application upon it.

In the Government's brief below we find the contention advanced that "an invention is not made until it has been completed and reduced to practice. Until that has been done it is a mere idea or conception (Automatic W. M. Co. v. Pneumatic, etc., 166 Fed Rep., 288)." This decision, however, rather supports our contentions than those of the Government, as is evidenced by the following holding of the court on pages 291 and 292, to-wit:

> *"In patented inventions there are several distinct stages of the invention. Some patented inventions comprise only three stages, namely conception (evidenced by drawings, disclosures, models), application, patent; while other patented inventions comprise four stages, namely, conception, reduction to practice, application, patent.*
>
> *"The date of the first class of patented inventions must be either (1) the date of the patent, or (2) the date of the application, or (3) the date of the conception; while the date of the second class must be either (1) the date of the patent, or (2) the date of the application, or (3) the date of the reduction to practice, or (4) the date of the conception.*
>
> *"When two patents for the same invention have been issued to independent inventors, we understand the rule to be that the dates of their respective inven-*

tions are first, the dates of the patents; second the dates of the applications, provided the application sufficiently describes the invention; third, the dates of actual reduction to practice; fourth, the dates of conception; with this qualification, that, if either patentee seeks to carry the date of his invention back to the date of his conception, he must show reasonable diligence in adapting and perfecting his invention, either by actual reduction to practice or by filing his application."

Applying that ruling to the present case, we find that if appellant's invention is one of the first class all three of his dates occurred during the time when he was not in the Government service; while if it be of the second class, three of the four dates occurred outside of the time of his Government employment, and the date of the fourth, namely, the date of the reduction to practice, may or may not have occurred outside of such period. For while the petition did set up that the invention was finally completed in May, 1914, which was during his period of Government service, there is no averment inconsistent with the contention that he had actually reduced his invention to practice before the time when he entered upon that service, to-wit, March, 1913. Indeed, from the fact that he claims to have been inventing the tool during ten years prior to March, 1913, and in view of the further averment that prior to his leaving the Government service "this tool has been constantly used with great success on United States war vessels in said yard" (Petition, par. 5), it would appear that there had been a reduction to practice before he had ever entered upon his service at the Bremerton Navy Yard.

We must not lose sight in this case of the fact that appellant's patent application was not filed until July 29, 1914, which was thirteen days after he had severed his connection with the Government; nor of the presumption of law that

the invention was made at the date of the application. (Kearney v. Railroad Company, 32 Fed., 320; National Machine Company v. Brown, 36 Fed., 317; Prindle v. Brown, 155 Fed., 531; Bates v. Coe, 98 U. S., 31, Lorraine v. Thurmond, 51 O. G., 1782.)

Quoting further from the case of Automatic Weighing Machine Company v. Pneumatic, etc., *supra*, upon which opposing counsel has seen fit to rely, we find the following on page 296:

> "At the same time we have the equally well settled rule that an invention need not be perfected and adapted to use, or reduced to practice, in order to obtain a valid patent, since no such condition is contained in the statutes.
>
> "This question of reduction to practice arose in the case of Wheeler v. Clipper Mower & Reaper Company, 6 Fish., 1, 16, Fed. Cas. No. 17,493. In the opinion in that case Judge Woodruff said:
>
> > 'On the argument it was insisted that the patent is void if the patentee did not reduce the invention to practical use before the patent was obtained.
> >
> > 'This proposition is wholly unsound. No such condition is required by the act of Congress; and if it were true that a patent would be void on that ground, no patent could be properly granted unless proof was furnished that the invention claimed had gone into practical use, which is not, and can not, under the statute, be made a condition of granting the patent. It is enough that the inventor has perfected his invention, and is able to furnish to the Patent Office such specifications and model as the law requires. Having done this, the patent, in so far as prerequisites to its validity, either by way of experiment or use, are material, is valid.'

"If any doubt ever existed, however, upon this point, it was conclusively settled by the Supreme Court in the Telephone Cases, 126 U. S., 1, 535. In that case Mr. Chief Justice Waite, speaking for the court, said:

> 'But it is insisted that the claim can not be sustained, because when the patent was issued Bell had not in fact completed his discovery. While it is conceded that he was acting on the right principle and had adopted the true theory, it is claimed that the discovery lacked that practical development which was necessary to make it practicable. In the language of counsel, there was still work to be done, and work calling for the exercise of the uttermost ingenuity, and calling for the very highest degree of practical invention.
>
> 'It is quite true that when Bell applied for his patent he had never actually transmitted telegraphically-spoken words so that they could be distinctly heard and understood at the receiving end of his line, but in his specification he did describe accurately and with admirable clearness his process—that is to say, the exact electrical condition that must be created to accomplish his purpose; and he also described, with sufficient precision to enable one of ordinary skill in such matters to make it, a form of apparatus which, if used in the way pointed out, would produce the required effect, receive the words, and carry them to and deliver them at the appointed place. * * *
>
> 'The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation.'"

Under these authorities and others which might be cited it should be held that the date of Mr. Moore's invention is either October 27, 1914,—when he was not in the Government service; or July 29, 1914—when not in the Government service; or some date in the year 1903—when not in the Government service; or some uncertain date in the years 1903 to 1914, inclusive—when he may or may not have been in the Government service. That date is a matter to be established by competent evidence at a hearing, and could not be established upon the argument of this motion to dismiss.

It is also true that if Mr. Moore can show that he used reasonable diligence, after his conception of the invention in the year 1903, to reduce the same to practice, then he is entitled to the date of that conception as the date of his invention. This question of due diligence is also one to be established by competent evidence, and can not be determined on the preliminary motion to dismiss.

We, therefore, maintain that under the clear and unambiguous words of the statute this claim does fall within the Act of June 25, 1910.

APPELLANT DID NO INVENTING DURING GOVERNMENT WORKING HOURS, HENCE HIS CASE NOT WITHIN THE PROVISO OF THE STATUTE.

The words in the proviso of the Act of June 25, 1910, relied upon by the Government, to-wit, "during the time of his employment or service," we submit referred to those hours of the inventor's time during which he was actually employed and for which he was paid, not to those hours when having served the Government fully and faithfully during the entire day, he was entitled to a period of rest and recreation or study, and became once again his own master for a brief period, or until the grinding drudgery

of departmental work commenced on the following morn.

To adopt defendant's contention in this respect would be to hold virtually that any one entering into Government service sold his entire body and brains to the Government and became a slave, as it were, during the entire period of his employment. To carry the argument to a logical conclusion, no eminent writer who for the purpose of a support or to secure opportunities of study by being in near access to the Congressional Library, or other Government sources of information, should be able to secure a copyright on his books written at night or on Sundays or during his vacation. No sculptor employed during the day time in a Government office should be entitled to the work of his hand and brain. In short, every one enlisting under the United States Government, either in its civil or its military branches, would be an intellectual slave and obliged to give to the Government the entire fruits of his labor during the entire period of his employment.

Manifestly this was not the intent of the statute and only by a strained construction of the law could it be so contended. What the statute did mean was that a Government employee can not use the Government's time, the Government's facilities and the assistance of other Government employees to conceive or perfect an invention and then prevent the Government from afterwards having the use of it without compensation. And especially does it mean that those scientists who are employed in such branches of the Government as the Agricultural Department, the Geological Survey, the Bureau of Mines, especially to devise and perfect inventive ideas for the benefit of the people at large, shall not have exclusive property in them. So this court held in the Solomons case (137 U. S., 342), from which the Government has quoted in its brief below.

And we urge that the law has been just the same in this respect since the passage of the Act of 1910 as before.

We advert again to the circumstances that the said Act of 1910 was a remedial statute and should therefore be construed liberally. The mischief designed to be remedied by it was that inventors given a patent by the United States Government after all the forms of law had been complied with, were helpless as against the acts of the Government itself, except after petitioning Congress to be allowed to bring suit in the Court of Claims and expending their time and money in having a bill passed or referred and suffering from the numerous and lengthy delays usually experienced by claimants before Congress. This mischief would not be remedied as to a large class of important inventors if the court adopts the narrow construction of the words "time of his employment or service" contended for by the Government.

Of course, an inventor might seek to prevent the proper construction of the law by claiming that he did all his work at home when as a matter of fact he did use Government time or Government facilities. But that question is a matter of proof and not one for disposition on a preliminary motion to dismiss. In such a workshop as the Bremerton Navy Yard numerous witnesses would be obtainable, if this appellant had been guilty of such act. The circumstances that Mr. Moore frankly admits in his petition, as to the period of his inventing, should be convincing of his good faith in this matter even though proof were not easily obtainable by the Government as to the actual facts.

We have been unable to locate any authorities bearing directly upon the case, for that portion of the Act of 1910 here in question has never been construed by any court; nor do we find that the words "the time of his employment or service" have in any other statute gone before the courts

for construction. But in two cases in the State reports similar words have been construed in the manner for which we contend.

Thus in State v. Deck (108 Mo. App., 292., 83 S. W., 314, 315), the Missouri court passed on a statute prohibiting the employment of child labor in certain manufacturing establishments, and held, "merely to *employ* a child to work in one of these establishments does not complete the offense. The offense is not completed until the youth hired *is put to* work or employed in the establishment."

In Louisville and N. R. R. Co. v. Wade (46 Fla., 197, 35 South., 863, 864), there was construed Section 3 of Chapter 471, page 114, of the acts of the State of Florida of 1891, providing that "if any person is injured by a railroad company by its locomotives, or cars, or other machinery of such company, *he being at the time of such injury an employee of the company*, and the damage was caused by negligence of another employee, and without fault or negligence on the part of the person injured, his employment by the company shall be no bar to a recovery. It was held that the rule as to fellow servants had no application to one who, though in the employment of the principal whose servant's negligence occasioned the injury was not when injured engaged in the performance of his duties as such employee and was engaged in the pursuit of his own ends, citing Wood on Master and Servant, Sec. 404; Wink v. Weiler, 41 Ill. App., 336; Doyle v. Fitchburg Rd. Co., 162 Mass., 66, 37 N. E., 770, 25 L. R. A., 157; Washburn v. Nashville & C. R. R. Co., 3 Head (Tenn.), 638; 75 Am. Dec., 784. "One so injured therefore is not an employee within the meaning of the present statute."

It needs no argument to demonstrate that one is not an employee of the company outside of the actual hours of his employment with the company and that if he is injured

outside of those hours he has not been injured "during the time of his employment or service." The same rule should be applied to an inventor who scrupulously refrains from working on his device during the hours when he is paid for services by the Government, but instead gives to it his time and attention only when not in the Government pay, and when naturally the work of his hands and his brain are his own property.

THE DEBATES IN CONGRESS PRECEDING PASSAGE OF THE ACT OF 1910 UPHOLD OUR CONTENTION AS TO ITS PROPER CONSTRUCTION.

Defendant in its brief below has quoted from the debates in Congress leading up to the passage of the statute in question, and thus acknowledged that the language of that statute is ambiguous since it is a fundamental rule that recourse must be had to such debates only in the event of ambiguity.

However, we urge that these debates prove the intent of Congress in passing the Act of 1910 to have been to allow the Government to us an invention patented by its employee only when Government time, Government material or Government money has been used in making or perfecting the invention. Thus on pages 8757 and 8758 of Volume 45, Congressional Record (61st Congress, 2nd Session), we find the following:

> "Mr. Norris. I would like, in order to understand the legal proposition, to put a question in the way of an illustration: Suppose that an individual were employed by the Government in the Post Office Department and his work brought him in contact with the particular department where they were cancelling stamps, let us say, and during his employment in carrying out that work for the Government he secured ideas that he developed into a machine and had it pat-

ented, that was of no use except to cancel postage stamps, and hence of no value to anybody outside of the Government. *Now, would that individual be entitled under this bill or under the present law, either one, to damages from the Government if he goes and takes a patent out on it?*

Mr. Currier. *Clearly so; unless he uses the Government's time in perfecting that invention; if he did it out of hours.*

Mr. Douglas. How will anybody know?

Mr. Norris. *He may not attempt to use the Government's time, and I can see how time might be a very material part of the invention and the ideas he secured while in the employ of the Government.*

Mr. Currier. *Oh, certainly.*

Mr. Norris. We never would have a patent, unless we permitted a man of that kind who might secure an advantage by being there—

Mr. Currier. Nobody else would have an opportunity.

Mr. Norris. Because nobody but the Government would care for a patent for cancelling stamps.

Mr. Currier. May I say to the gentleman, nearly all the inventions in ordnance and everything of that kind in war material must necessarily come from government officers and employees.

Mr. Douglas. I do not think that the gentleman can maintain any such assertion. The greatest inventions in reference to war material have been made by men like Maxim and others who had nothing whatever to do with the Government.

Mr. Currier. There are many cases of that kind, but you will find most cases where the inventors are employees.

Mr. Mann. *Is the purpose of this bill to let these employees of the Government who take out patents for war material make the Government pay for the use of them?*

Mr. Currier. *I want to say 'yes.'*

Mr. Mann. *I thought it was.*

Mr. Currier. *If they get ideas and, without using Government materials or money, produce an invention; yes. They can do it now if the courts can find an implied contract.*

Mr. Goldfogle. Why should they not come to Congress and present their case?

Mr. Mann. Why should we pass a bill and put an incentive in the mind of every Government employee at the expense of the Government and in the time of the Government, to find some patented device that the Government will use and go out of the Government service and sue the Government for the use of it.?

Mr. Graham of Pennsylvania. *As a member of the Committee on Claims, I can state that we have had a dozen applications requiring the Government to be honest to a patentee. We have not passed out but a single one of those claims. We have not time to investigate them. This bill simply allows the Court of Claims to pass on the cases. It is a bill to require the United States Government to live up to the eighth commandment, 'Thou not steal.' What right have they to steal a man's patent?"*

(Italics here, and throughout this brief, are ours.)

In commenting upon this the defendant's brief below states that this discussion "was referring apparently to the existing state of the law prior to the proposed act, the Government being no different from any other employer," but the fact is shown by the debate itself to be otherwise. Thus Mr. Norris' question was with regard to a right of a patentee "under this bill or under the present law, either one," and the explanation given to him and to Congressman Mann was as "to the purpose of this bill."

Thus, even if reference is had to the Congressional debates, it will be found that the broad and liberal construction of the law, for which we are contending, was actually intended by the law-making body.

We have been compelled to discuss the Government's

brief below because the Court of Claims rendered no opinion in this case, and hence we presume upheld the Government's contentions, or reached its conclusion by a similar line of reasoning.

III.

Conclusion.

In conclusion, we suggest that in addition to this case being very important to the future of this appellant, whose ideas have been appropriated and used by the Government to its own advantage, it may prove of vast importance to the large and ever-increasing number of Government employees, including millions of men working on the railroads, the telegraph and cable systems, and the merchant marine of the United States, not to mention those in the Army and Navy. We are hence confident that this court will consider the matter very carefully, not only from the standpoint of the language actually employed in the statute of 1910, but from the standpoint of the intent of Congress in enacting that statute. And "the pledge of the good faith of the Government which the statute plainly implies," to use the words of Mr. Chief Justice White in the Crozier case (*supra*), would be entirely lost if it is to be held that no inventor can recover under it if at any time during the years he may have worked upon his invention he was employed in any branch of the Government service.

With a prayer that the decision of the court below be reversed and the appellant permitted the opportunity of establishing the allegations of his petition by evidence, this case is

Respectfully submitted,

Samuel Herrick,
Attorney for Appellant.

P. M. Lamoy,
Of Counsel.

No. 278.

In the Supreme Court of the United States

October Term, 1919

Daym F. Mouse, appellant,

v.

The United States.

APPEAL FROM THE COURT OF CLAIMS.

BRIEF FOR THE UNITED STATES.

WASHINGTON: GOVERNMENT PRINTING OFFICE, 1919.

In the Supreme Court of the United States.

OCTOBER TERM, 1918.

DAVID F. MOORE, APPELLANT,
v.
THE UNITED STATES.
No. 278.

APPEAL FROM THE COURT OF CLAIMS.

BRIEF FOR THE UNITED STATES.

This case comes from the Court of Claims, where a petition seeking to recover $30,000 for the use by the United States, without license, of a patented reefing tool was dismissed for want of jurisdiction.

STATUTE INVOLVED.

Appellant bases his right to sue in the Court of Claims upon the act of June 25, 1910 (36 Stat., 851), which is as follows:

> AN ACT To provide additional protection for owners of patents of the United States, and for other purposes. (36 Stat. L., 851.)
>
> *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such

owner may recover reasonable compensation for such use by suit in the Court of Claims:

Provided, however, (1) That said Court of Claims shall not entertain a suit or reward compensation under the provisions of this act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States:

Provided further, (2) That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty of the Revised Statutes, or otherwise:

And provided further, (3) That the benefits of this act shall not inure to any patentee who, when he makes such claim is in the employment or service of the United States; or the assignee of any such patentee; nor shall this act apply to any device discovered or invented by such employee during the time of his employment or service.

THE FACTS.

The petition as finally amended alleged that from March 26, 1913, until July 16, 1914, the appellant was in the employ of the United States, working at the navy yard at Bremerton, Wash., first as a first-class wood-calker, and afterwards in charge of the wood-calking crew. During the month of May, 1914, it was alleged, after expending a great deal of time, labor, and study, he completed the invention of the tool in question. On July 29, 1914, 13 days after

he left the employment of the Government, he applied for a patent, which was granted October 27, 1914. He alleged that prior to the issuance of the patent the tool had been constantly used with great success on United States war vessels in the navy yard above mentioned, but that on or about July 16, 1914, when he left the employ of the Government he forbade its use, but that, regardless of his instructions, the officials and employees of the Government continued using it and are still using it. He therefore sued upon the ground that the United States had used his invention without license or lawful right. It will be seen that he expressly alleged that he was in the employ or service of the Government when he completed his invention. In the effort to escape the last proviso of the act above quoted, he alleged that "during the years 1903 to 1914, inclusive, he invented" the tool in question. But, as stated above, this was coupled with the allegation that the invention was completed in May, 1914.

In a further effort to escape this proviso he also alleged, referring to his employment by the Government, that "during the hours of his said employment petitioner did no work upon his invention, but that such work as was performed upon it subsequent to March 26, 1913, was performed at petitioner's home during his absence from duty at the said Bremerton Navy Yard."

RULING OF THE COURT BELOW.

The Court of Claims sustained a motion to dismiss without rendering an opinion, but manifestly upon

the ground that because appellant completed his invention while in the employ or service of the Government the court had no jurisdiction to entertain his claim.

BRIEF.

The allegation that the Government used this tool in the face of the fact that appellant had forbidden its use and regardless of his instructions, excludes the possibility that there was either an express or implied contract which would authorize the Court of Claims to entertain the claim under its general jurisdiction. The case is plainly one for an unlawful infringement of a patent. The Court of Claims was therefore clearly without jurisdiction, unless such jurisdiction was conferred by the act of 1910 above quoted.

This court has recently considered the act in question and very plainly stated the reasons for its enactment. After reviewing the rights of patentees under the law existing prior to 1910, it was stated as a result:

> (*d*) That where an officer of the United States in dealing with a subject within the scope of his authority infringed patent rights by a taking or use of property for the benefit of the United States without the conditions stated justifying the implication of a contract, however serious might be the infringement or grave to the holder of the rights the consequences of such infringement, the only redress of the owner was against the officer, since no ground for implying a contract and securing compensation from the United States ob-

tained. (*Cramp & Sons* v. *Curtis Turbine Company*, 246 U. S., 28, 40, 41.)

The defect in the law intended to be cured by the act of 1910, therefore, was to give the right to sue the United States for an infringement of patents. To accomplish this, jurisdiction was conferred in a new class of cases upon the Court of Claims. The act was a consent by Congress that the United States might be sued in certain cases in which it could not theretofore have been sued, and was intended to determine in what class of cases this right to sue should exist. In order to maintain an action, therefore, a claimant must bring himself strictly within the terms of the act.

By the first section the right to recover reasonable compensation for the use without license or lawful right of a patent by the United States was broadly given to the owners of patents. If this was all there would be no doubt that the appellant would have the right to maintain a suit. But Congress was not willing to extend this right generally to all owners of patents, and hence it made the first section subject to three provisos. By the first proviso it excluded from the benefits of the act the owner of any patent claimed to be infringed by the use of articles which prior to the passage of the act were owned, leased, used by, or in the possession of the United States. The allegation of the petition that prior to the issuance of the patent the tool in question had been constantly used with great success on United States war vessels leaves it at least doubtful whether the appellant is not excluded by this proviso. For aught that ap-

pears this use by the Government may have commenced prior to June 25, 1910. If any effect is to be given to the allegation that the appellant invented the tool in question during the years 1903 to 1914, so that it can be said to have been in any sense invented prior to the time appellant entered the service of the Government, it may be that the Government was using it when the act of 1910 was passed. In this view, by not alleging that the use by the Government began subsequent to that date, the appellant failed to state a case.

The second proviso gave to the United States the same defenses that would be available to any other defendant in an action for the infringement of a patent. And the third proviso withheld the right to sue from any person in the employ or service of the Government. This would have prevented the appellant from bringing his suit as long as he remained in the service of the Government. He did not, however, attempt to sue until his employment by the Government had terminated. Hence this part of the proviso does not exclude him from the right to maintain his suit. But the proviso goes further, and provides that the act shall not "apply to any device discovered or invented by such employee during the time of his employment or service." This is the language which denied to the Court of Claims jurisdiction in this case.

The proviso just quoted has not heretofore been construed by the court. Its language, however, would seem to be too plain and simple to admit of

any difficulty in its construction. The language of appellant's petition is specific to the effect that this invention was completed in May, 1914, when he was in the service of the Government. This, in connection with the other allegation that it was invented during the years 1903 to 1914, inclusive, can only mean that, as also alleged, the appellant had during those years expended a great deal of time, labor, and study in the effort to invent this tool, and that after all this time so expended he finally succeeded in making the invention in May, 1914.

A thing is done when it is completed, and not before. Prior to that time one may have been engaged in doing it, but only when it has been completed can it be said to have been done. An uncompleted invention is not an invention. A partially invented device can not be said to have been invented. So it follows that the most that can be claimed from the allegations of the petition is that when the appellant entered the service of the Government he was working on an invention. It may be said that at that time he had made some progress toward the invention of the tool in question, but upon his own statement he did not complete this progress and hence did not invent the tool until May, 1914. His device, therefore, is one which is in the plainest language excluded from the benefits of the act of 1910 because invented during the time that he was in the employ or service of the Government.

The appellant, however, seeks to escape by alleging that he worked on this invention only during the

hours when he was not required by his employment to be working for the Government. But the language of the act will not fairly bear any such construction. It is "during the time of his employment or service," that is, during the period of time when he is in the employ or service of the Government.

As stated above, there are two parts to the proviso in question. In order to exclude *employees* of the Government from the right to sue, the language used was that the benefits of the act "shall not inure to any patentee, who, when he makes such claim, is *in the employment or service of the Government of the United States.*" Immediately following is the language by which certain *devices* are excluded, and the language used is, "any device discovered or invented by such employee *during the time of his employment or service.*"

Plainly the expressions "in the employment or service of" and "during the time of his employment or service" mean exactly the same thing, that is, during the period of time when the employment or service continues. The theory of appellant is that because he was only required to work for the Government during certain hours of the day, he was not in the employment or service of the Government during the remaining hours within the meaning of this proviso. If this is the proper construction of the last clause, it is equally the proper construction of the first. The first clause prevents him from bringing suit when he is in the employment or service of the Government. It is scarcely conceivable that

any one would say that a regular employee of the Government leaving his work at 4.30 in the afternoon could go immediately to the Court of Claims and file a suit, and then insist that the first clause of the proviso did not apply, because he filed the suit, not "during hours" of his employment, but during his absence from duty. No more can it be said that he did not invent a device "during the time of his employment or service" because the work done on the invention was done during the hours when he was off duty. During the whole time that the appellant was on the pay roll of the Government he was in its employ or service, although the day was divided into hours of work and hours of rest. It is respectfully submitted that the language of the act is too plain to admit of doubt.

If, however, it could be said that there is any possible doubt or ambiguity about the language used, an examination of the debates and committee reports which led to the passage of the act, as reported in volume 45 of the Congressional Record, Part VIII, pages 8755 to 8757, 8779 to 8785, 8868 and 9043, will remove this doubt. When the bill was introduced it did not contain the proviso now in question, and the discussion showed very clearly that the purpose of the author was to make the Government liable for the use of a device, although invented by an employee, if the work done in its invention was done "out of hours." But after this discussion the present proviso was offered as a substitute for a much broader proviso

which had been offered, and in explanation of the proviso, as finally adopted, its author said:

> This amendment simply provides that the remedy given by this act shall not inure to a patentee while *he is in the employ of the Government*, or to a claim discovered by *an employee of the Government*, and I think this is as far as the act ought to go.

This, it is submitted, is exactly what the proviso does mean. Whether it is a wise policy to, in effect, give the Government the power to use, without compensation, a device invented by its employees is now beside the question. Congress has passed on the question of policy and the result is this: An employee of the Government inventing a device and obtaining a patent for it has exactly the same rights against all the world that any other patentee has, except that if the Government infringes his patent he has no remedy. The proviso in question, in effect, prevents him from recovering at any time from the Government for an infringement of a patent on an article invented by him during the period of his employment, and it likewise suspends his right to sue the Government for the infringement of a patent on an article invented by him previous to his employment, so long as he remains in the service of the Government. As against all other infringers he has the same rights that any other patentee has. It may, or it may not be, that this act is unwise, as discouraging efforts which might lead to valuable inventions, but that is a

question which Congress alone can decide, and which Congress has decided.

It is respectfully submitted that the judgment of the Court of Claims should be affirmed.

WILLIAM L. FRIERSON,
Assistant Attorney General.

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